

REMARKS

In accordance with the foregoing, claims 1 and 27 have been amended. Claims 1-11, 27-31, 36, and 37 are pending, with claims 1 and 27 being independent. No new matter is presented in this Amendment.

New Examiner Required to Give Full Faith and Credit to Search and Action of Previous Examiner

The Office Action of June 30, 2008, and all of the previous Office Actions in the present application were issued by Primary Examiner Aristotelis M. Psitos. However, as of the filing date of November 10, 2008, of this Amendment, the application was assigned to Supervisory Patent Examiner (SPE) Wayne R. Young, who was Mr. Psitos' supervisor, reportedly because Mr. Psitos has retired. It is presumed that the application will be reassigned to yet another Examiner for the actual consideration of the present Amendment. The new Examiner's attention is directed to MPEP 704.01, which states as follows on MPEP page 700-6:

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something. See MPEP § 719.05.

Accordingly, it is respectfully requested that the new Examiner comply with these guidelines when responding to the present Amendment.

Request for Careful Study of Application by Supervisory Patent Examiner

The Office Action of June 30, 2008, is the fifth Office Action that has been issued in the present application, and is also the third Office Action that has been issued since the Request for Continued Examination of May 21, 2007, was filed. Also, the present application was filed on September 30, 2003, and thus has been pending for more than five years. Accordingly, the new

Examiner's attention is directed to MPEP 707.02, which states as follows on MPEP page 700-115 (emphasis added):

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner

Accordingly, it is respectfully requested that the new Examiner bring this situation to his Supervisory Patent Examiner's (SPE's) attention so that the SPE can carefully study the application with a view toward terminating its prosecution.

Request for Correction of Image File Wrapper

The image file wrapper of the present application lists a one-page document dated May 19, 2008, with a document code of "OA.APPENDIX" and a document description of "Office Action Appendix." However, this document is actually an Interview Summary for the personal interview conducted on May 15, 2008. Accordingly, it is respectfully requested that the Examiner take the necessary steps to have the image file wrapper corrected to list the Interview Summary with the proper document code of "EXIN" and the proper document description of "Examiner Interview Summary Record (PTOL - 413)."

The image file wrapper of the present application lists a 12-page document dated June 30, 2008, with a document code of "OA.APPENDIX" and a document description of "Office Action Appendix." However, this document is actually a copy of JP 4-113563 cited by the Examiner in the Office Action of June 30, 2008. Accordingly, it is respectfully requested that the Examiner take the necessary steps to have the image file wrapper corrected to list this document with the proper document code of "FOR" and the proper document description of "Foreign Reference."

The image file wrapper of the present application lists a three-page document dated June 30, 2008, with a document code of "DRW" and a document description of "Drawings-only black and white line drawings." However, this document is actually a copy of replacement FIG. 3 and new FIGS. 5 and 6 submitted with the Amendment of February 29, 2008, marked "okay to enter" by the Examiner. It is submitted that it is improper for this document to be identified as "Drawings-only black and white line drawings" because this might lead to confusion in printing the drawings of any patent issuing from the present application. However, it is not known what the appropriate document code and document description for this document would be. In any event, it is respectfully requested that the Examiner take the necessary steps to have the image file wrapper corrected to list this document with the proper document code and the proper document description, whatever they may be.

Request for Corrected Marked-Up Copy of List of References Cited by Applicant

The Office Action of June 30, 2008, includes a copy of the List of References Cited by Applicant from the Information Disclosure Statement of May 28, 2008, in which the Examiner has placed his initials next to the listings of US 6,108,152 and WO 2/052551, has not placed his initials next to the listing of the Supplementary European Search Report, has signed and dated the List of References Cited by Applicant, and has placed the notation "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /A.P./" at the bottom of the List of References Cited by Applicant.

However, it is submitted that the presence of the Examiner's initials next to the listings of US 6,108,152 and WO 2/052551 coupled with the absence of the Examiner's initials next to the listing of the Supplementary European Search Report might cause confusion in printing the "References Cited" section of any patent issuing from the present application, and result in the Supplementary European Search Report not being listed in the "References Cited" section.

Also, it is noted that the listing of WO 2/052551 is incorrect, and should be WO 02/052551 as pointed out on page 10 of the Supplemental Amendment of June 5, 2008, which included a List of References Cited by Applicant listing this reference correctly as WO 02/052551.

Accordingly, it is respectfully requested that the Examiner provide a corrected marked-up copy of the List of References Cited by Applicant from the Information Disclosure Statement of May 28, 2008, signed and dated by the Examiner with a line drawn through the incorrect listing of WO 2/052551 and the notation "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /A.P./" at the bottom with the next Office Action.

Drawings

On page 2 of the Office Action of June 30, 2008, the Examiner states as follows:

The drawings filed 2/29/08 have been approved and are entered. However, since replacement sheet for figure 3 filed on 10/12/07 has been approved, the figure 3 submitted with the above sheets (of 2/29/08) now needs to be re-corrected.

The Examiner is apparently referring to the fact that replacement FIG. 3 submitted with the Amendment of February 29, 2008, does not include the changes in replacement FIG. 3 submitted with the Amendment of October 12, 2007, which were made to show the features "sync body" and "sync identification that satisfies the RLL (d,k) code" that are recited in the claims. However, these features were purposely omitted from replacement FIG. 3 submitted with the Amendment of February 29, 2008, because these features are now shown in new FIGS. 5 and 6 submitted with the Amendment of February 29, 2008. As indicated on pages 7 and 15 of the Amendment of February 29, 2008, replacement FIG. 3 submitted with the Amendment of February 29, 2008, replaces replacement FIG. 3 submitted with the Amendment of October 12, 2007. Accordingly, it is submitted that replacement FIG. 3 submitted with the Amendment of February 29, 2008, does not now need to be re-corrected as alleged by the Examiner.

Errata

On page 2 of the Office Action of June 30, 2008, under the heading "Errata," the Examiner states as follows:

As recited, the independent claims call for a user data area and an additional data area, wherein the additional data area has a 2nd sync signal which then comprises of a 3rd and 4th sync signal.

Reviewing the disclosure and figure 2, the additional data area is defined as area 2, where in [sic] the 2nd sync area (23) comprises of a second and third sync component 23a, 23b. The examiner makes the following conclusions; [sic]

The additional data area comprises of a plurality of data areas, and in order to have a 3rd and 4th sync there must be at least two additional data areas.

The following art rejections are predicated upon the above interpretation.

However, contrary to the Examiner's interpretation, what FIG. 2 actually shows is one additional data area D containing a plurality of additional data 21 separated by a plurality of second sync patterns 23 comprising a third sync pattern 23a and a fourth sync pattern 23b. See, for example, paragraph [0015] of the specification. Accordingly, to the extent that the rejections of claims 1-11, 27-31, 36, and 37 over the prior art are based on an incorrect interpretation of independent claims 1 and 27 by the Examiner, is it submitted that the Examiner has not established a *prima facie* case of obviousness under 35 USC 103(a).

Furthermore, should the Examiner reject claims 1-11, 27-31, 36, and 37 in the next Office Action based on a different interpretation of independent claims 1 and 27, it is submitted that this will constitute a new ground of rejection that was not necessitated by this Amendment, such that the Examiner will not be able to make the next Office Action final.

Claim Rejections Under 35 USC 103

Rejection 1

Claims 1, 2, 27, and 29 have been rejected under 35 USC 103(a) as being unpatentable over "Isozaki et al [sic] ('142) considered with JP 04-113563 and both further considered with Olmedo and all further considered with Tanaka et al [sic] and Hedlund et al." as indicated on page 3 of the Office Action of June 30, 2008. Accordingly, it is the applicants' understanding that this means that claims 1, 2, 27, and 29 have been rejected under 35 USC 103(a) as being unpatentable over Isozaki et al. (Isozaki) (U.S. Patent No. 6,470,142) in view of JP 4-11356, Olmedo (U.S. Patent No. 6,174,170), Tanaka et al. (Tanaka) (U.S. Patent No. 5,881,037), and Hedlund et al. (Hedlund) (U.S. Patent No. 4,142,209).

However, in the third full paragraph on page 4 of the Office Action of June 30, 2008, the Examiner has also relied on Hirayama et al., which is presumably U.S. Patent No. 5,715,356 to Hirayama et al. cited by the Examiner in the Office Action of July 12, 2007. It is respectfully requested that the Examiner confirm this in the next Office Action.

Thus, it is the applicants' understanding that claims 1, 2, 27, and 29 actually have been rejected under 35 USC 103(a) as being unpatentable over Isozaki et al. (Isozaki) (U.S. Patent No. 6,470,142) in view of JP 4-11356, Olmedo (U.S. Patent No. 6,174,170), Tanaka et al. (Tanaka) (U.S. Patent No. 5,881,037), Hirayama et al. (Hirayama) (U.S. Patent No. 5,715,356), and Hedlund et al. (Hedlund) (U.S. Patent No. 4,142,209). This rejection is respectfully traversed.

Claims 1 and 27

It is submitted that Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, and Hedlund do not disclose or suggest "a user data area" and an additional data area located before and/or after the user data area" as recited in independent claims 1 and 27.

The Examiner states as follows in pertinent part in explaining the rejection:

Isozaki et al [*sic*] discloses the ability of providing both video and audio information upon a record medium. The examiner interprets the video data as the claimed user data, and the audio data as the additional data area. Note that both the video and audio data areas can in themselves comprise of a plurality of areas.

As noted starting in col. 8 line 25 to col. 10 line 53, different syncs are required for the video and audio data.

. . . .

Furthermore, as additional [*sic*] taught by the Olmedo reference, text data can also be provided in this environment (along with audio).

. . . .

The examiner has taken into consideration the emphasis (during the interview [of May 15, 2008]) with respect to the claimed phrases "user data" and "additional data". However, there is no prohibition from the claims to not limit the "user data" to the above identified video data. Furthermore, there is nothing to prohibit the interpretation of "user" data area as merely that of 1 field/frame of

video data. And hence any data areas subsequent to such data area(s) are "additional data area(s)".

Thus, the Examiner considers Isozaki to disclose video data and audio data. The Examiner considers Isozaki's video data to be "user data" as recited in claims 1 and 27, and considers Isozaki's audio data to be "additional data" as recited in claims 1 and 27. However, it is submitted that Isozaki's video data and audio data are both user data because they are both used by a user of Isozaki's VTR.

The Examiner also considers Olmedo to disclose text data areas, which the Examiner considers to be "additional data area[s]" as recited in claim 1. However, it is submitted that the text data that is stored in Olmedo's text data areas is user data because it is used by a user of Olmedo's information storage medium.

With respect to the Examiner's statement that "there is no prohibition from the claims to not limit the 'user data' to the above identified video data," the Examiner is reminded that the words of a claim must be given their "plain meaning" unless such meaning is inconsistent with the specification (see MPEP 2111.02(I) on MPEP page 2100-38), and that "plain meaning" refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art (see MPEP 2111.02(III) on MPEP page 2100-39). Here, it is submitted that the meaning that those of ordinary skill in the art would give to the term "user data" in claims 1 and 27 is data that is used by a user. Since Isozaki's audio data and Olmedo's text data are used by a user, it is submitted that one of ordinary skill in the art would consider Isozaki's audio data and Olmedo's text data to be types of "user data" as recited in claims 1 and 27, rather than being "additional data" as recited in claims 1 and 27 as alleged by the Examiner.

With respect to the Examiner's statements that "there is nothing to prohibit the interpretation of "user" data area as merely that of 1 field/frame of video data," and that "hence any data areas subsequent to such data area(s) are 'additional data area(s)'," it is submitted that one of ordinary skill in the art would consider any video data areas, audio data areas, and text data areas subsequent to "1 field/frame of video data" to be additional user data areas, rather than additional data areas" as recited in claims 1 and 27 as alleged by the Examiner. It appears that the Examiner has overlooked the difference between an "additional data area" as recited in claims 1 and 27 and an additional user data area as arguably disclosed by Isozaki and Olmedo.

Furthermore, it is submitted that Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, and Hedlund do not disclose or suggest the following combination of additional features now recited in claims 1 and 27:

the information storage medium is a read-only information storage medium; and

the additional data area is provided to make the read-only information storage medium compatible with a recordable information storage medium.

It is submitted that the audio data areas in which Isozaki's audio data is recorded are provided to enable Isozaki's VTR to record audio data, rather than being provided "to make [a] read-only information storage medium compatible with a recordable information storage medium" as now recited in claims 1 and 27.

Furthermore, it is submitted that Olmedo's text data areas are provided to enable Olmedo's information storage medium to store text data, rather than being provided "to make [a] read-only information storage medium compatible with a recordable information storage medium" as now recited in claims 1 and 27.

Furthermore, it is not seen where JP 4-11356, Tanaka, Hirayama, and Hedlund disclose or suggest the feature "to make [a] read-only information storage medium compatible with a recordable information storage medium" now recited in claims 1 and 27.

Claim 29

It is not seen where Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, and Hedlund disclose or suggest the feature "wherein the controller further controls the recording and/or reproducing unit to: determine another user data area comprising first sync patterns so that the additional data area is disposed between the user data area and the other user data area" recited in dependent claim 29. The Examiner did not specifically address this feature in explaining the rejection.

Conclusion—Rejection 1

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1, 2, 27, and 29 (i.e., claims 1, 27, and 29 discussed above and claim 2 depending from claim 1) under 35 USC 103(a) as being unpatentable over Isozaki in view of JP 4-11356, Olmedo, Tanaka, Hirayama, and Hedlund be withdrawn.

Rejection 2

Claims 8, 11, 30, and 31 have been rejected under 35 USC 103(a) as being unpatentable over "the art as applied to claims 1,2 and 27 as stated in paragraph 1 above, and further in view of either Ho et al [*sic*] or Roth et al [*sic*] ('335)." It is the applicants' understanding that this means that claims 8, 11, 30, and 31 have been rejected under 35 USC 103(a) as being unpatentable over Isozaki in view of JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, and either Ho et al. (Ho) (U.S. Patent No. 6,249,896) or Roth (U.S. Patent No. 6,188,335). This rejection is respectfully traversed.

It is submitted that Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, Ho, and Roth do not disclose or suggest the following feature of dependent claim 8 and 11:

each of the first sync identification, the third sync identification, and the fourth sync identification satisfies a run-length limited (RLL) (d, k) code having a minimum constraint of d and a maximum constraint of k,

or the following feature of dependent claim 30:

each of the first sync patterns comprises a first sync identification that satisfies a run-length limited (RLL) (d, k) code having a minimum constraint of d and a maximum constraint of k,

or the following feature of dependent claim 31:

each of the third sync identification and the fourth sync identification satisfies a run-length limited (RLL) (d, k) code having a minimum constraint of d and a maximum constraint of k.

The Examiner considers column 1, line 39, through column 3, line 20, of Ho or column 3, line 65, through column 4, line 67, of Roth to teach these features of claims 8, 11, 30, and 31.

The most relevant portion of column 1, line 39, through column 3, line 20, of Ho appears to be column 2, lines 14-19, which reads as follows:

FIG. 2 shows a DVD sync mark. Sync mark 10 is a 32-bit string of bits that are divided into two groups 22, 24. Group 1 (24) is a special sequence of bits that does not occur in the channel data bits. It is a violation of the (2,10) RLL code, since it contains a run of 13 zeros. The sequence of group 1 is identical for each sync mark.

Thus, this portion of Ho appears to teach the opposite of what is recited in claims 8, 11, 30, and 31, which recite that the various sync identifications satisfy a run-length limited (RLL) (d, k) code.

With respect to column 3, line 65, through column 4, line 67, of Roth relied on by the Examiner, although this portion of Roth mentions (d,k)-RLL codes, it does not mention anything whatsoever about sync identifications as recited in claims 8, 11, 30, and 31, or even about sync. Accordingly, it is not understood why the Examiner considers Roth to teach the sync identification features recited in claims 8, 11, 30, and 31.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 8, 11, 30, and 31 under 35 USC 103(a) as being unpatentable over Isozaki in view of JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund and either Ho or Roth be withdrawn.

Rejection 3

Claims 3, 5, 6, 9, 10, and 28 have been rejected under 35 USC 103(a) as being unpatentable over "the art as applied to claims 1,2 and 27 as stated in paragraph 1 above, and further in view of Koshino et al." It is the applicants' understanding that this means that claims 3, 5, 6, 9, 10, and 28 have been rejected under 35 USC 103(a) as being unpatentable over Isozaki in view of JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, and Koshino et al. (Koshino) (U.S. Patent No. 7,254,316). This rejection is respectfully traversed.

Claims 3, 9, and 28

Although the propriety of this rejection is not conceded, it is submitted that dependent claims 3, 9, and 28 are patentable over Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama,

Hedlund, and Koshino for at least the same reasons discussed above that claims 1 and 27 from which claims 3, 9, and 28 directly or indirectly depend are patentable over Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, and Hedlund.

Claims 5, 6, and 10

It is submitted that Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, and Koshino do not disclose or suggest the feature "a total size of additional data recorded in the additional data area is an integer multiple of a size of each of a plurality of user data recorded in the user data area and separated by the first sync patterns" recited in dependent claims 5, 6, and 10.

The Examiner apparently considers Koshino to teach this feature of claims 5, 6, and 10, but the Examiner did not address the "integer multiple" aspect of this feature in explaining the rejection, and it is not seen where Koshino teaches this feature.

Conclusion—Rejection 3

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 3, 5, 6, 9, 10, and 28 under 35 USC 103(a) as being unpatentable over Isozaki in view of JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, and Koshino be withdrawn.

Rejection 4

Claims 36 and 37 have been rejected under 35 USC 103(a) as being unpatentable over "the art as applied to claims 11 and 31 as stated in paragraph 2 above, and further in view of either Ho et al [*sic*] or Roth et al [*sic*] ('335)." It is the applicants' understanding that this means that claims 36 and 37 have been rejected under 35 USC 103(a) as being unpatentable over Isozaki in view of JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, and either Ho or Roth, which is the same combination of references relied on by the Examiner in the rejection of claims 8, 11, 30, and 31. This rejection is respectfully traversed.

Although the propriety of this rejection is not conceded, it is submitted that dependent claims 36 and 37 are patentable over Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund,

Ho, and Roth for at least the same reasons discussed above that claims 1 and 27 from which claims 36 and 37 indirectly depend are patentable over Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, and Hedlund, and that claims 11, 30, and 31 from which claims 36 and 37 directly or indirectly depend are patentable over Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, Ho, and Roth.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 36 and 37 under 35 USC 103(a) as being unpatentable over Isozaki in view of JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, and either Ho or Roth be withdrawn.

Rejection 5

Claims 4 and 7 have been rejected under 35 USC 103(a) as being unpatentable over "the art as applied to claims 3 and 6 as stated in paragraph 3 above, and further in view of either Ho et al [*sic*] or Roth et al [*sic*] ('335)." It is the applicants' understanding that this means that claims 4 and 7 have been rejected under 35 USC 103(a) as being unpatentable over Isozaki in view of JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, Koshino, and either Ho or Roth. This rejection is respectfully traversed.

It is submitted that Isozaki, JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, Koshino, Ho, and Roth do not disclose or suggest the feature "each of the first sync identification, the third sync identification, and the fourth sync identification satisfies a run-length limited (RLL) (d, k) code having a minimum constraint of d and a maximum constraint of k" recited in dependent claims 4 and 7.

The Examiner considers column 1, line 39, through column 3, line 20, of Ho or column 3, line 65, through column 4, line 67, of Roth to teach these features of claims 4 and 7. However, it is submitted that these portions of Ho and Roth do not teach this feature of claims 4 and 7 for at least the same reasons discussed above that Ho and Roth do not teach the same feature of claims 8 and 11.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 4 and 7 under 35 USC 103(a) as being unpatentable over Isozaki in view of JP 4-11356, Olmedo, Tanaka, Hirayama, Hedlund, Koshino, and either Ho or Roth be withdrawn.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

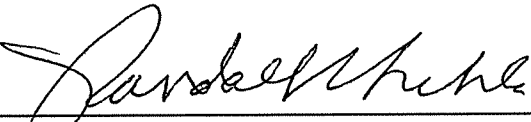
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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Date: 11/10/08

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